

REMARKS

A. 35 U.S.C. § 103

1. Kuhara et al.

a. Claims 15, 16, 18-21 and 24

In the Office Action of June 15, 2005, claims 15, 16, 18-21 and 24 were rejected under 35 U.S.C. §103 as being obvious in view Kuhara et al. Applicants traverse this rejection. In particular, independent claim 18 recites an optoelectronic transceiver that includes a substrate element having a first electrical conductor track and a second electrical conductor track. The Office Action concedes that Kuhara et al. fails to disclose a substrate having two electrical conductor tracks. Despite this failure, the Office Action asserts that “it would have been obvious to obtain a first electrical conductor and a second electrical conductor track.” However, the Office Action does not provide any credible motivation for using the proposed electrical conductors. Indeed, the Office Action has failed to explain how such electrical conductors are to be used with the substrate element and other components of Kuhara et al. This is evidence that an improper “obvious to try” standard is being used to reject claim 18.

The rejection is improper for the additional reason that Kuhara et al. fails to suggest using an optoelectronic receiving unit electrically connected to an electrical conductor track of a substrate element and is disposed in bridge-like fashion above an

optoelectronic transmitting unit along a common optical axis via a spacer attached to the substrate. The Office Action concedes that Kuhara et al. fails to use an optoelectronic receiving unit disposed in a bridge-like fashion in the manner recited in claim 18. The Office Action asserts that it would have been obvious to use such a bridge-like structure “in order to provide the data signal for the optical transmitter and receiving the data signals from the optical receiver separately and to reduce the interference between the signals and to increase the signal noise ratio.” The Office Action fails to provide credible motivation for using the recited bridge-like structure. In particular, the Office Action asserts that 1) submount 168 corresponds to the recited substrate and 2) laser diode 70 corresponds to the recited optoelectronic receiving unit. As shown in FIG. 24A, Kuhara et al.’s submount 168 is used to mount laser diode 70 to a base. Now the Office Action proposes placing submount 168 above the laser diode 70. This proposal makes no sense in that it would require laser diode 70 to be connected directly to the base, which is not desired, and submount 168 would perform no beneficial purpose. Since there is no motivation for such an arrangement, the rejection is improper and should be withdrawn.

b. Claims 25-27, 29-35 and 38

Claims 25-27, 29-35 and 38 were rejected under 35 U.S.C. §103 as being obvious in view Kuhara et al. Applicants traverse this rejection. In particular, claim 25 was previously canceled in Applicants’ Amendment filed on January 27, 2005 and so its

rejection is moot. Regarding independent claim 29, it recites a radiation transmission system that includes 1) a substrate element having two electrical conductor tracks and 2) an optoelectronic receiving unit electrically connected to an electrical conductor track and is disposed in bridge-like fashion above the optoelectronic transmitting unit. The above two items labeled 1) and 2) are recited in claim 18. Accordingly, the rejection is improper for at least the same reasons given above in Section A.1.a.

2. Kuhara et al. and Bucholz

a. Claim 17

Claim 17 was rejected under 35 U.S.C. §103 as being obvious in view of Kuhara et al. and Bucholz. Claim 17 depends indirectly on claim 18. As pointed out previously in Section A.1.a, Kuhara et al. fails to disclose or suggest 1) submount 168 having two electrical conductor tracks and 2) placing submount 168 above the laser diode 70. Bucholz does not cure the deficiencies of Kuhara et al. since it does not suggest altering Kuhara et al. so that 1) submount 168 has two electrical conductor tracks and 2) submount 168 is placed above the laser diode 70. Without such suggestion, the rejection is overcome and should be withdrawn.

b. Claim 28

Claim 28 was rejected under 35 U.S.C. §103 as being obvious in view of Kuhara et al. and Bucholz. Claim 28 depends indirectly on claim 29. As pointed out in Section

A.1.b, Kuhara et al. fails to disclose or suggest 1) submount 168 having two electrical conductor tracks and 2) placing submount 168 above the laser diode 70. Bucholz does not cure the deficiencies of Kuhara et al. since it does not suggest altering Kuhara et al. so that 1) submount 168 has two electrical conductor tracks and 2) submount 168 is placed above the laser diode 70. Without such suggestion, the rejection is overcome and should be withdrawn.

B. New Claim 39-40

New claims 39 and 40 depend directly on claims 18 and 29, respectively, and so are patentable for at least the same reasons given above in Section A.1 as to why claims 18 and 29 are patentable.

Claims 39 and 40 have been added so as to provide additional coverage for the inventions of claims 18 and 29, respectively. Accordingly, new claims 38 and 39 are not being presented for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

CONCLUSION

In view of the arguments above, Applicants respectfully submit that all of the pending claims 15-21, 24, 26-35 and 38-40 are in condition for allowance and seek an

early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,



John C. Freeman
Registration No. 34,483
Attorney for Applicants

BRINKS HOFER
GILSON & LIONE
P.O. Box 10395
Chicago, Illinois 60610
(312) 321-4200

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